

Remarks

This is responsive to the Office Action mailed May 20, 2005. The amendments and remarks are proper, do not introduce new matter, do not require additional searching, and are not narrowing in view of a prior art rejection.

Errors/Unresolved Issues

The rejections in the first Office Action, as understood by the Applicant, do not satisfy the threshold obligations for thoroughness and completeness prescribed in 37 C.F.R. 1.104(a). Particularly, independent claims 1, 2, 10, and 17 recite a *channel* for supportingly engaging each of the data storage devices; the Examiner has construed the *channel* as being anticipated by the switch block 178 of Anderson '926. The switch block 178 in no understandable way satisfies the structural and functional features of the *channel* of the present embodiments as claimed. Also, the Examiner's construction of claim 2 in means-plus-function format is without basis in the law.

Applicant's representative M. McCarthy made every attempt to discuss this case with Mr. Duong before filing this response because it is believed the basis for the rejection is in error. Mr. McCarthy spoke with Mr. Duong on August 18, 2005, requesting a telephone interview to clarify the basis for the rejection. Mr. Duong indicated that an interview might be granted, but that Applicant must first submit an interview request form. Mr. McCarthy explained that time was short; that a timely reply had to be filed by August 22nd. Mr. Duong responded that Mr. McCarthy should've called earlier. Mr. McCarthy explained that he only wanted to know how the switch block 178 anticipates the claimed *channel*; Mr. Duong still insisted on the interview request form before an interview would be granted. To Mr. McCarthy's inquiry, Mr. Duong

replied that the form should be faxed to the number indicated in the Office Action. Mr. McCarthy faxed the interview request form on August 18th.

Mr. McCarthy followed up on the morning of August 19th, and discovered that Mr. Duong had not received the interview request form. Mr. Duong requested that the form be faxed to a different number and Mr. McCarthy complied immediately.

Mr. Duong telephoned Mr. McCarthy on the afternoon of August 22nd and indicated that it did appear that the Office Action was mistaken in reading the switch block 178 on the claimed *channel*; that is was likely a typographical mistake. However, it had become too late for Mr. Duong to correct the mistake because a timely reply was due that day. Mr. Duong and Mr. McCarthy agreed that the only thing to do was for Mr. McCarthy to reply to the Office Action as it stood.

Although the Applicant has responded timely, the next Office Action cannot be made final because the first Office Action does not satisfy the requirements for thoroughness and completeness of 37 C.F.R. 1.104(a).

Rejection Under Section 102(b)

Claims 1-21 were rejected as being anticipated by Anderson '926. This rejection is respectfully traversed.

Claim 1

Anderson '926 cannot sustain a Section 102 rejection of claim 1 because it fails to identically disclose all the recited features of the present embodiments, including at least the following:

An array storage system...comprising a carrier from a plurality of different carriers differentiated by a characteristic array of

tubular closed channels, each channel adapted for supportingly engaging a data storage device.
(excerpt of claim 1, emphasis added)

Sustaining a Section 102 rejection requires the Examiner make a factual finding that each and every limitation is found either expressly or inherently in a single prior art reference.

Celeritas Techs. Ltd. v. Rockwell Int'l Corp., 47 USPQ2d 1516 (Fed. Cir. 1998). The present embodiments as claimed contemplate an array storage system comprising a plurality of different carriers. The carriers are differentiated by a characteristic array of *tubular closed channels*, each *channel* adapted for supportingly engaging a data storage device.

In rejecting claim 1 the Examiner cited FIG. 6 of Anderson '926 that discloses a structural enclosure made of a bottom enclosure 122 attached to a top enclosure 124. Each of the disk drives 136, 138, 140, and 144 are attached to a separate mounting board, and are supported in the enclosure by sliding an edge of the mounting board through channels 150 that are attached to or formed in the bottom enclosure 122. (Anderson '926, col. 11 lines 5-13) The Applicant wishes to point out that the channels 150 are U-shaped, not *tubular closed channels* as in the present embodiments as claimed.

Curiously, however, the Examiner read Anderson '926's switch block 178 of each of the disk drives as anticipating the recited *channel* of the present embodiments. The switch block 178 is accessible to the user through openings 170 in the bezel 126. Anderson '926 discloses in the different embodiments that the switch block 178, sometimes otherwise referred to such as "identification selection switch" and "address select switch," is used as determined by the disk manufacturer and the operating software to select and identify the relative position of the particular disk drive within the plurality of disk drives in the enclosure. (see, for example, Anderson '926 col. 5 lines 39-44)

The Examiner read the switch block 178 on the *channels* straightforwardly, giving no explanatory details in the detailed action as to how an electrical switch anticipates a *tubular closed channel*; the Applicant can only surmise it is due to a mistake. Applicant's attempts to discuss the apparent error with the Examiner were not received cooperatively. Whatever the Examiner's intended basis, the switch block 178 does not define a *tubular closed channel* adapted for supportingly engaging the data storage device. The Examiner's claim construction is unreasonable because it ignores both plain meaning and the explicit definition in the specification of the claim term *channel*. *In re Morris*, 43 USPQ2d 1753 (Fed. Cir. 1997).

Accordingly, Anderson '926 cannot sustain the Section 102 rejection because it fails to identically disclose all the features of the present invention as claimed. Reconsideration and withdrawal of the present rejection of claim 1 are respectfully requested.

Furthermore, the switch block 178 and the Examiner's remarks do not even sustain a colorable argument for anticipating the recited *channel*; accordingly, the first Office Action with respect to the rejection of claim 1 does not satisfy the Examiner's obligations of thoroughness and completion dictated by 37 C.F.R. 1.102(a), such that the next action on the merits rightfully cannot finally reject claim 1.

Claim 2

First, the amendment to claim 2 is broadening in scope of the contemplated embodiments; particularly, the amendment is not narrowing in view of a prior art rejection.

Furthermore, Anderson '926 cannot sustain a Section 102 rejection of claim 2 because it fails to identically disclose all the recited features of the present embodiments, including at least the following:

A multiple disc array comprising...means for urging the data storage device against the circuit board.
(excerpt of claim 2, emphasis added)

The *means for urging* element of claim 2 invokes 35 U.S.C. §112, sixth paragraph.

Accordingly, the Examiner is obliged to construe the means clause as covering the disclosed structure and equivalents thereof performing the identical function of the claimed embodiments. See *B. Braun Medical, Inc. v. Abbott Lab.*, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997); *In re Donaldson Co. Inc.*, 26 USPQ2d 1845 (Fed. Cir. 1994)(*en banc*); *In re Dossel*, 42 USPQ2d 1881 (Fed. Cir. 1997); *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, Para. 6*, 65 FR 38510. A failure to do so is reversible error.

The Applicant has explicitly identified the function associated with the recited *means for urging* as being damping the data storage device and positively connecting the data storage device with the electrical connector. (see, for example, specification pg. 8 beginning at line 4; pg. 10 beginning at line 3; FIGS. 7 and 8 and the corresponding discussions thereof)

The Examiner stated the following in rejecting claim 2 over Anderson '926: "the means 156 for urging is characterized by a fastener for attaching the data storage device 136, 138, 140 to a channel surface." (Office Action of May 20, 2005, pg. 2) This basis for rejection clearly evidences an erroneous construction of claim 2 and is reversible error.

The rejection is erroneous firstly because item 156 of Anderson '926, to which the Examiner refers, is an electrical connector. But Anderson '926 is wholly silent regarding any structure of the electrical connector that either damps vibration or positively engages the data storage device. The rejection is erroneous secondly because the disclosed structure contemplated by claim 2 does not contemplate "a fastener for attaching the data storage device...to a channel

surface.” Although it is unclear what fastener the Examiner is referring to, nevertheless such a structure would likely be beyond the equivalents of the disclosed structure.

When the means element is properly construed, it is clear that Anderson ‘926 does not disclose or suggest any structure capable of the identical function as the present embodiments as claimed. Accordingly, independent claim 2 and the claims depending therefrom are allowable over the art of record. Reconsideration and withdrawal of the rejection of claim 2 and the claims depending therefrom are respectively requested.

Furthermore, the connector 156 and the Examiner’s remarks do not even sustain a colorable argument for anticipating the recited *means for urging*; accordingly, the first Office Action with respect to the rejection of claim 2 does not satisfy the Examiner’s obligations of thoroughness and completion dictated by 37 C.F.R. 1.102(a), such that the next action on the merits rightfully cannot finally reject claim 2 or any claim depending therefrom.

Claim 10

First, the amendment to claim 10 is broadening in scope of the contemplated embodiments; particularly, the amendment is not narrowing in view of a prior art rejection.

Furthermore, Anderson ‘926 cannot sustain a Section 102 rejection of claim 10 because it fails to identically disclose all the recited features of the present embodiments, including at least the following:

A carrier...comprising channel surfaces defining a tubular closed passage....
(excerpt of claim 10, emphasis added)

For at least the same reasons as discussed above for claim 1, the switch block 178 of Anderson ‘926 does not anticipate the *channel surfaces defining a tubular closed passage* of the

present embodiments as claimed. Applicant's attempts to discuss the apparent error with the Examiner were not received cooperatively. Whatever the Examiner's intended basis, the switch block 178 does not define a *tubular closed passage* for supportingly engaging the data storage device. The Examiner's claim construction is unreasonable because it ignores both plain meaning and the explicit definition in the specification of the claim terms *channel surfaces* and *tubular closed passage*. *In re Morris*, 43 USPQ2d 1753 (Fed. Cir. 1997).

Accordingly, Anderson '926 cannot sustain the Section 102 rejection because it fails to identically disclose all the features of the present invention as claimed. Reconsideration and withdrawal of the present rejection of claim 10 and the claims depending therefrom are respectfully requested.

Furthermore, the switch block 178 and the Examiner's remarks do not even sustain a colorable argument for anticipating the recited *channel surfaces defining a tubular closed passage*; accordingly, the first Office Action with respect to the rejection of claim 10 does not satisfy the Examiner's obligations of thoroughness and completion dictated by 37 C.F.R. 1.102(a), such that the next action on the merits rightfully cannot finally reject claim 10 or any claim depending therefrom.

Claim 17

First, the amendment to claim 17 is broadening in scope of the contemplated embodiments; particularly, the amendment is not narrowing in view of a prior art rejection.

Furthermore, Anderson '926 cannot sustain a Section 102 rejection of claim 17 because it fails to identically disclose all the recited features of the present embodiments, including at least the following:

A method...comprising providing a carrier defining an array of tubular closed channels for supportingly engaging data storage devices....

(excerpt of claim 17, emphasis added)

For at least the same reasons as discussed above for claims 1 and 10, the switch block 178 of Anderson '926 does not anticipate the *tubular closed channels* of the present embodiments as claimed. Applicant's attempts to discuss the apparent error with the Examiner were not received cooperatively. Whatever the Examiner's intended basis, the switch block 178 does not define a *tubular closed channel* for supportingly engaging the data storage device. The Examiner's claim construction is unreasonable because it ignores both plain meaning and the explicit definition in the specification of the claim terms *tubular closed channels*. *In re Morris*, 43 USPQ2d 1753 (Fed. Cir. 1997).

Accordingly, Anderson '926 cannot sustain the Section 102 rejection because it fails to identically disclose all the features of the present invention as claimed. Reconsideration and withdrawal of the present rejection of claim 17 and the claims depending therefrom are respectfully requested.

Furthermore, the switch block 178 and the Examiner's remarks do not even sustain a colorable argument for anticipating the recited *tubular closed channels*; accordingly, the first Office Action with respect to the rejection of claim 17 does not satisfy the Examiner's obligations of thoroughness and completion dictated by 37 C.F.R. 1.102(a), such that the next action on the merits rightfully cannot finally reject claim 17 or any claim depending therefrom.

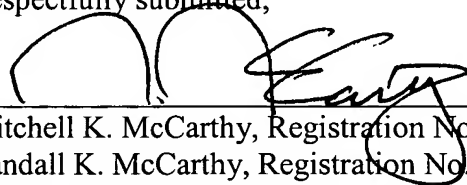
Conclusion

This is a complete response to the Office Action mailed July 11, 2005, as understood. The Applicant respectfully requests that the Examiner reconsider the application and allow all of

the pending claims. The Applicant has submitted herewith a request for telephone interview at a time to be determined by the Examiner if, after reviewing the amendments herein and before the next action on the merits, it is determined that all pending claims are not in condition for allowance. The telephone interview is necessary to ensure this case proceeds on the merits where the first Office Action did not do so.

Respectfully submitted,

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